

**PATENT APPLICATION**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Yuki SASAKI et al.

Group Art Unit: 1617

Application No.: 10/015,611

Examiner: L. WILLIAMS

Filed: December 17, 2001

Docket No.: 111482

For: RESIN POWDER FOR DERMATOLOGIC COMPOSITION, SKIN CLEANSING  
AGENT AND COSMETIC COMPOSITION USING THE POWDER, AND  
PREPARATION PROCESS OF THE POWDER

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicants hereby request review of the May 18, 2006 Final Rejection in this application. A Notice of Appeal and fee in the amount of \$500 are filed concurrently herewith.

I. Status of Pending Claims

Claims 1-22 are pending. Claims 18-22 are currently withdrawn. Claims 1-17 are rejected. No amendments are being filed with this request.

II. Grounds of Rejection Presented for Review

The following grounds of rejection are presented for review: (A) claims 1, 2, 4, 6-10 and 12-14 were rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent No. 6,080,519 (hereinafter Ishiyama); and (B) claims 3, 5, 11 and 15-17 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Ishiyama in view of U.S. Patent No. 5,976,750 (hereinafter Hagi).

Claim 1 is the rejected independent claim. Claim 1 recites a resin powder for a dermatologic composition, the resin powder comprising resin particles consisting essentially of a resin having an average volume particle size of 2.0 to 20.0  $\mu\text{m}$ , a shape factor SF1 of 110 to 140 and an average volume particle size distribution GSDv of 1.3 or less.

A. Ishiyama

Ishiyama is directed to a toner comprised of toner particles including colorant particles therein. Applicants submit that Ishiyama fails to teach or suggest the presently claimed resin powder, at least because Ishiyama requires colorant to function as a toner, but such colorant is excluded from the present claims. Specifically, the claims recite resin particles consisting essentially of a resin having an average volume particle size of 2.0 to 20.0  $\mu\text{m}$ , a shape factor SF1 of 110 to 140 and an average volume particle size distribution GSDv of 1.3 or less, and the colorant of Ishiyama negatively affects the basic and novel claim of the resin particles so as to be excluded from the claims.

The Patent Office alleges that Ishiyama teaches the resin particles of the claimed powder, and thus allegedly inherently teaches the associated properties thereof recited in the present claims. The Patent Office asserts that the resin particles "consisting essentially of" a resin is to be construed as the resin particles "comprising" a resin, allegedly because no clear indication of the basic and novel characteristics of the resin particles is set forth in the specification or claims. Applicants submit that this construction of claim 1 constitutes a clear error.

In claim 1 "consisting essentially of" should be construed to exclude any additional materials that affect the basic and novel characteristics of the resin particles of the claimed powder. MPEP 2111.03 indicates that although it may be appropriate to interpret "consisting essentially of" as "comprising" initially, an applicant can rebut the Patent Office's interpretation by establishing (1) where the specification indicates the basic and novel

characteristics and/or (2) that certain materials affect the basic and novel characteristics of the claimed item so as to be excluded.

First, the specification indicates that affinity to the skin, spreadability and smoothness are basic and novel characteristics associated with the resin particles and powder. As disclosed throughout the present specification, the resin powder for dermatologic composition is capable of attaining sufficient spreadability and skin adhesion upon application of a cosmetic composition or a skin cleansing composition to the skin. For example, see page 2, lines 25-27 to page 3, lines 1-2. The specification discloses that the resin particles affect these desired properties. See, for example, page 5, lines 7-23, page 6, lines 14-17, page 7, lines 11-25, page 8, lines 1-8, page 10, lines 10-13, Table 2 on pages 35 and 36 of the specification, etc. The powder of the present application exhibits excellent spreadability and skin adhesion as a result of the resin particles composition and properties, so that it is possible to add the powder to cosmetic compositions (see page 18, lines 20-23 of the present specification). Thus, the specification indicates spreadability and smoothness are basic and novel characteristics of the resin particles and powder. The Patent Office's assertions to the contrary are incorrect.

Second, the Patent Office further asserts that there is no clear evidence that a toner colorant materially affects the basic and novel characteristics of the resin particles in Ishiyama. Thus, the Patent Office alleges that the present claims do not exclude the colorants of Ishiyama. This is also incorrect.

In the Rule 132 Declaration filed on March 16, 2005, evidence was submitted that the presence of a colorant affects these basic and novel characteristics, including affinity to the skin, spreadability and smoothness. Specifically, the evidence showed that when resin particles containing colorants are produced, the colorants tend to aggregate and adhere to the surface of the resin particles. These precipitated colorants can become dislodged from the

surface of the resin particles during processing, such as cosmetic production, due to the colorants and resins having different hardness values. The hardness and shape of the dislodged colorant adversely affects the affinity to the skin, spreadability and smoothness of the resin particles and of the finished product, as shown on page 5, paragraphs 2-4 of the Declaration.

Affinity to the skin, spreadability and smoothness are plainly basic and novel characteristics required of resin particles of a resin powder for a dermatologic composition as claimed. Resin particles not having these properties would not be suitable in a dermatologic composition as claimed. As such, the previously filed Declaration provides evidence that the colorant as taught by Ishiyama is excluded by the recitation "consisting essentially of" as recited in claim 1.

For the foregoing reasons, Applicants submit that (1) the construction of the claims presently asserted by the Patent Office is erroneous and contrary to the proper guidelines set forth in MPEP 2111.03, and (2) Ishiyama does not teach or suggest claims 1, 2, 4, 6-10 and 12-14 because Ishiyama requires a component excluded from the present claims. Reconsideration and withdrawal of the rejection are thus respectfully requested.

B. Ishiyama in view of Hagi

The Patent Office relied on Hagi as allegedly teaching the specific GSDp, specific molecular weight, specific acid value range, or additional fine particles adhered to the resin particles. However, even if Ishiyama were to have been combined with Hagi as alleged by the Patent Office, the presently claimed subject matter still would not have been achieved because Hagi does not remedy the deficiencies of Ishiyama. Specifically, Hagi also does not teach or suggest a resin powder comprising resin particles consisting essentially of a resin as recited in claim 1. Hagi, like Ishiyama, requires a colorant in the toner particles.

Accordingly, Applicants submit that claims 3, 5, 11 and 15-17 are patentable over Ishiyama and/or Hagi. Reconsideration and withdrawal of the rejection are thus respectfully requested.

II. Conclusion

For all of the reasons discussed above, it is respectfully submitted that the rejections are in error and that all the pending claims are in condition for allowance. For all of the above reasons, Applicants respectfully request the panel of Examiners to review the May 18, 2006 Final Rejection prior to Appeal and to withdraw the rejections therein.

Respectfully submitted,

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